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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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SCHMEISER, OLSEN & WATTS 22 CENTURY HILL DRIVE SUITE 302 LATHAM, NY 12110			EXAMINER KAMAL, SHAHID	
			ART UNIT 3621	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/530,535	Applicant(s) CARRO ET AL.	
	Examiner Shahid Kamal	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 15-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 15-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>04/06/2005</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The Information Disclosure Statement filed on 06 April 2005 has been considered. An initialed copy of the Form 1449 is enclosed herewith.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patterson (US Patent No.: 6,389,541 B1) in view of Bell et al. (US Pub. No.: 2003/0130952).

Referring to claim 1, Patterson discloses identifying the selected item by correlating the determined position of the pressed point with a position of the selected item in a list of item positions recorded in an edited object table that is stored in the user workstation, said list of item positions being associated with file plurality of items on the portion of the physical document (see at least abstract & column 4, lines 1-12, column 7, lines 17-47);

- identifying an edited object in the edited objects table from association of the edited object with the selected item in the edited objects table (see at least column 4, lines 1-12, column 7, lines 17-47);
- ascertaining whether the user has a license to use and/or copy the edited object (see at least column 4, lines 13-28); and
- if said ascertaining ascertains that the user has the license then accessing the edited object from the user workstation and displaying the edited object, and if said ascertaining ascertains that the user does not have the license then obtaining the license and the edited object from an edited objects server (see at least column 10, lines 49-67).

Patterson does not expressly disclose determining a position of a point-pressed on a touch foil of an opto-touch foil aligned over or under a portion of the copyrighted physical document, said portion comprising a plurality of items, said point having been pressed to select an item of the plurality of items during illumination of the plurality of items by a light emitting-foil of the opto-touch foil, said pressed point aligned proximate to the selected item.

Bell et al. discloses determining a position of a point-pressed on a touch foil of an opto-touch foil aligned over or under a portion of the copyrighted physical document, said portion comprising a plurality of items, said point having been pressed to select an item of the plurality of items during illumination of the plurality of items by a light emitting-foil of the opto-touch foil, said pressed point aligned proximate to the selected item (see at least abstract & paragraphs 0071, 0075, fig.12).

Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified of Patterson to include the step(s) taught by Bell et al. as discussed above in order to provide to Access to private markets is controlled through passwords and through properties of account profiles such as group memberships.

Referring to claim 2, Patterson further discloses sending an order for the license to an edited objects server (see at least column 4, lines 13-28);

- receiving the edited object with the license from the edited server (see at least column 4, lines 13-28);
- storing the edited object in the user workstation (see at least abstract & column 1, lines 1-17, column 4, lines 13-29);
- updating in the edited objects table with a file path for accessing the stored edited object (see at least column 4, lines 1-12, column 7, lines 17-47);
- indicating in the edited objects table that the user has the license (see at least column 4, lines 13-28).

Referring to claim 3, Patterson further discloses wherein the edited objects server communicates with the user workstation via an internet communication network (see at least abstract).

Referring to claim 4, Patterson does not expressly discloses wherein the physical document is a printed document comprising at least one page(s) and wherein (a) the portion of the physical document is a page of the at least one page.

Bell et al. discloses wherein the physical document is a printed document comprising at least one page(s) and wherein (a) the portion of the physical document is a page of the at least one page (see at least abstract & paragraphs 0071, 0075, fig.12).

Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified of Patterson to include the step(s) taught by Bell et al. as discussed above in order to provide to Access to private markets is controlled through passwords and through properties of account profiles such as group memberships.

Referring to claim 5, Patterson does not expressly discloses wherein the order for the license comprises an identification of the selected physical document the page, the selected item, and payment data relating to the selected item.

Bell et al. discloses wherein the order for the license comprises an identification of the selected physical document the page, the selected item, and payment data relating to the selected item (see at least abstract & paragraphs 0071, 0075, fig.12).

Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified of Patterson to include the step(s) taught by Bell et al. as discussed above in order to provide to Access to private markets is controlled through passwords and through properties of account profiles such as group memberships.

Referring to claim 6, Patterson further discloses wherein the edited object comprises a chapter, notes, a picture, a video element, or an audio element (see at least abstract).

Referring to claim 7, Patterson further discloses wherein said sending the order for the license to the edited objects server comprises sending required payment data to the edited objects server (see at least column 4, lines 13-28).

Referring to claim 8, Patterson further discloses wherein said sending the order for the license to the edited objects server comprises sending to the edited object server, a request for information concerning the edited object, and wherein the method further comprises, receiving the requested information from the edited objects server (see at least column 4, lines 13-28); and

- displaying or playing the received information concerning the edited object (see at least abstract).

Referring to claim 9, Patterson further discloses license term and condition (see at least column 4, lines 13-28);

- pricing and ordering information (see at least fig. 8); and
- an identification of the physical documents the page and the selected item (see at least abstract).

Referring to claim 10, Patterson further discloses wherein said ascertaining comprises ascertaining whether a file path to the edited object in the edited objects table exists on the user workstation and if said ascertaining ascertains that said file path exists on the user workstation then said ascertaining ascertains that the user has the license (see at least column 4, lines 13-28, column 10, lines 49-67).

Referring to claim 11, Patterson further discloses wherein the edited objects table comprises rows and columns, wherein each row is associated with a unique edited

object and wherein the columns comprises a column for item position a column for item name, and column for the file path for accessing the edited object (see at least abstract).

Referring to claim 12, Patterson further discloses wherein the user workstation is selected from the group consisting of an Internet enable cell phone, an Internet appliance, a multimedia Personal Computer (PC), a set-top box, a WebTV, a game console, and a wireless IP enabled device (see at least column 1, lines 51-67, column 2, lines 49-67).

Referring to claim 15, Patterson discloses identifying the selected item by correlating the determined position of the pressed point with a position of the selected item in a list of item positions recorded in an edited object table that is stored in the user workstation, said list of item positions being associated with file plurality of items on the portion of the physical document (see at least abstract & column 4, lines 1-12, column 7, lines 17-47);

- identifying an edited object in the edited objects table from association of the edited object with the selected item in the edited objects table (see at least column 4, lines 1-12, column 7, lines 17-47);
- ascertaining whether the user has a license to use and/or copy the edited object (see at least column 4, lines 13-28); and
- if said ascertaining ascertains that the user has the license then accessing the edited object from the user workstation and displaying the edited object, and if said ascertaining ascertains that the user does not have the license then obtaining the

license and the edited object from an edited objects server (see at least column 10, lines 49-67).

Patterson does not expressly disclose determining a position of a point-pressed on a touch foil of an opto-touch foil aligned over or under a portion of the copyrighted physical document, said portion comprising a plurality of items, said point having been pressed to select an item of the plurality of items during illumination of the plurality of items by a light emitting-foil of the opto-touch foil, said pressed point aligned proximate to the selected item.

Bell et al. discloses determining a position of a point-pressed on a touch foil of an opto-touch foil aligned over or under a portion of the copyrighted physical document, said portion comprising a plurality of items, said point having been pressed to select an item of the plurality of items during illumination of the plurality of items by a light emitting-foil of the opto-touch foil, said pressed point aligned proximate to the selected item (see at least abstract & paragraphs 0071, 0075, fig.12).

Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified of Patterson to include the step(s) taught by Bell et al. as discussed above in order to provide to Access to private markets is controlled through passwords and through properties of account profiles such as group memberships.

Referring to claim 16, Patterson further discloses sending an order for the license to an edited objects server (see at least column 4, lines 13-28);

- receiving the edited object with the license from the edited server (see at least column 4, lines 13-28);
- storing the edited object in the user workstation (see at least abstract & column 1, lines 1-17, column 4, lines 13-29);
- updating in the edited objects table with a file path for accessing the stored edited object (see at least column 4, lines 1-12, column 7, lines 17-47);
- indicating in the edited objects table that the user has the license (see at least column 4, lines 13-28).

Referring to claim 17, Patterson further discloses wherein said sending the order for the license to the edited objects server comprises sending to the edited object server, a request for information concerning the edited object, and wherein the method further comprises, receiving the requested information from the edited objects server (see at least column 4, lines 13-28); and

- displaying or playing the received information concerning the edited object (see at least abstract).

Referring to claim 18, Patterson further discloses license term and condition (see at least column 4, lines 13-28);

- pricing and ordering information (see at least fig. 8); and
- an identification of the physical document the page, and the selected item (see at least abstract).

Referring to claim 19, Patterson further discloses wherein said ascertaining comprises ascertaining whether a file path to the edited object in the edited objects

table exists on the user workstation and if said ascertaining ascertains that said file path exists on the user workstation then said ascertaining ascertains that the user has the license (see at least column 4, lines 13-28, column 10, lines 49-67).

Referring to claim 20, Patterson discloses identifying the selected item by correlating the determined position of the pressed point with a position of the selected item in a list of item positions recorded in an edited object table that is stored in the user workstation, said list of item positions being associated with file plurality of items on the portion of the physical document (see at least abstract & column 4, lines 1-12, column 7, lines 17-47);

- identifying an edited object in the edited objects table from association of the edited object with the selected item in the edited objects table (see at least column 4, lines 1-12, column 7, lines 17-47);
- ascertaining whether the user has a license to use and/or copy the edited object (see at least column 4, lines 13-28); and
- if said ascertaining ascertains that the user has the license then accessing the edited object from the user workstation and displaying the edited object, and if said ascertaining ascertains that the user does not have the license then obtaining the license and the edited object from an edited objects server (see at least column 10, lines 49-67).

Patterson does not expressly disclose determining a position of a point-pressed on a touch foil of an opto-touch foil aligned over or under a portion of the copyrighted physical document, said portion comprising a plurality of items, said point having been

pressed to select an item of the plurality of items during illumination of the plurality of items by a light emitting-foil of the opto-touch foil, said pressed point aligned proximate to the selected item.

Bell et al. discloses determining a position of a point-pressed on a touch foil of an opto-touch foil aligned over or under a portion of the copyrighted physical document, said portion comprising a plurality of items, said point having been pressed to select an item of the plurality of items during illumination of the plurality of items by a light emitting-foil of the opto-touch foil, said pressed point aligned proximate to the selected item (see at least abstract & paragraphs 0071, 0075, fig.12).

Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified of Patterson to include the step(s) taught by Bell et al. as discussed above in order to provide to Access to private markets is controlled through passwords and through properties of account profiles such as group memberships.

Referring to claim 21, Patterson further discloses sending an order for the license to an edited objects server (see at least column 4, lines 13-28);

- receiving the edited object with the license from the edited server (see at least column 4, lines 13-28);
- storing the edited object in the user workstation (see at least abstract & column 1, lines 1-17, column 4, lines 13-29);
- updating in the edited objects table with a file path for accessing the stored edited object (see at least column 4, lines 1-12, column 7, lines 17-47);

- indicating in the edited objects table that the user has the license (see at least column 4, lines 13-28).

Referring to claim 22, Patterson further discloses wherein said sending the order for the license to the edited objects server comprises sending to the edited object server, a request for information concerning the edited object, and wherein the method further comprises, receiving the requested information from the edited objects server (see at least column 4, lines 13-28); and

- displaying or playing the received information concerning the edited object (see at least abstract).

Referring to claim 23, Patterson further discloses license term and condition (see at least column 4, lines 13-28);

- pricing and ordering information (see at least fig. 8); and
- an identification of the physical documents the page and the selected item (see at least abstract).

Referring to claim 24, Patterson further discloses wherein said ascertaining comprises ascertaining whether a file path to the edited object in the edited objects table exists on the user workstation and if said ascertaining ascertains that said file path exists on the user workstation then said ascertaining ascertains that the user has the license (see at least column 4, lines 13-28, column 10, lines 49-67).

4. Examiner's Note: The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the patent examiner should be directed to Shahid Kamal whose telephone number is (571) 270-3272. The Patent examiner can normally be reached on Monday-Thursday (9:00am -7:00pm), Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Khoi Tran can be reached on (571) 272-6919. The fax phone number for this origination where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published application may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-directed.uspto.gov>.

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Should you have any questions on accessing to the Private PAIR system, contact the Electronic Business Center (EBC) at 1(866) 217-9197 (toll free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 1(800) 786-9199 (IN USA OR CANADA) or 1(571) 272-1000.

Shahid Kamal
January 4, 2008


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